

REMARKS

This Amendment is submitted in response to the office action of March 31, 2004. In that action, claims 1-28 were allowed; only claim 29 was rejected as anticipated by the disclosure of USP 5,205,289 (Hurst). For the reasons set forth below, we respectfully submit that applicant's claim 29 as amended is patentably distinguishable over Hurst.

Amended Claim 29 Defines Allowable Subject Matter

Claim 29 has been amended to more specifically define the limitations and features of allowed claims 1-28. Claim 29 now recites a method of packaging the condom as secured to the compressed applicator, where the compressed applicator has a circumference not substantially greater than the condom circumference. Also included is the limitation that the opening of the expanded applicator is greater than the compressed applicator circumference.

The inclusion of these limitations conforms the subject matter of claim 29 to that defined by allowed claims 1-28.

Furthermore, as discussed more fully below, the prior art reference relied upon does not appear to contemplate, let alone anticipate, applicant's invention.

Claim 29 is Directed to a Packaging Limitation Not Disclosed or Suggested by the Prior Art

Claim 29 is directed to "a method of packaging a device including a condom and condom applicator supporting the condom". At page 14, of the specification it is taught that "the

applicator 2 is then packaged to be held in its compressed configuration, for example by a keeper band". This specification continues at line 16:

"In order to use the condom, the keeper band or other packaging holding the applicator 2 in the compressed configuration is removed. Advantageously, the applicator 2 will not automatically spring into its expanded configuration upon the removal of the packaging, although this is possible in some embodiments of the present invention."

We have carefully read the entire disclosure of the Hurst patent and can find absolutely no reference to packaging. In fact, the Hurst device contemplates a reusable "bellows member" that is of substantial construction. The manufacturing and marketing costs associated with the Hurst bellows would appear to be substantial, as compared to those of the various embodiments disclosed and claimed by the present applicant.

In describing the use of his device, Hurst contemplates that the user is obliged to handle the condom (which presumably must be removed by the user from its own individual package as provided by the condom manufacturer). The user then must secure it to the much larger open end of the bellows member. The diameter of the bellows member is not variable; rather it is of rigid construction.

The approach taught by Hurst clearly does not contemplate a pre-packaged combination of a condom and compressed applicator. We therefore respectfully submit that Hurst is not properly relied upon under §102 since it provides absolutely no teaching or suggestion of how the Hurst device might be packaged. Most significantly, Hurst teaches that the user must himself

manually secure the condom to the open end of the bellows member applicator.

Favorable reconsideration and withdrawal of the rejection of claim 29 is respectfully requested.

Drawing Requirement

Applicant has noted the requirement raised in the draftperson's letter for formal drawings. Upon receipt of confirmation of the allowance of claim 29, formal drawings will be prepared for submission.

Conclusion

The only substantive issue raised in the office action related to claim 29 and we have shown that the basis of the rejection should be withdrawn in view of the amendment of claim 29. All claims are believed to be in condition for allowance. Prompt issuance of a notice to that effect is respectfully requested.

Respectfully submitted,

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